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10/665,066

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Pankaj Patel

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EXAMINER

FELTON, MICHAEL J

ART UNIT

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1791

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/665,066 | Applicant(s) PATEL ET AL. | |
| | Examiner MICHAEL J. FELTON | Art Unit 1791 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 13-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 19-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 2007 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/27/2007 has been entered.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the cigarette wrapper and multiple coating layers must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Currently no drawings are found that illustrate a cigarette paper with coatings.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The current application contains product by process claims. Such claims are handled as laid out in MPEP section 2113.

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted) ...

"The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983) ...

"[T]he lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

MPEP section 2113

Claim **1-12, 20, 22-27, 29-32, 34-37, and 39-42** are rejected under 35 U.S.C. 103(a) as being obvious over by United States Patent No. 5,878,753 to Peterson et al. ("Peterson") in view of United States Patent No. 3,102,543 to O'Siel et al ("O'Siel").

As for claim 1, Peterson teaches:

- A wrapping material substrate [col. 1 lines 5-15],
- A plurality of bands [figures 2-4], and
- A pattern [figure 2].

The step, depositing layers of a coating formulation in a pattern on the substrate, is deemed not to impart patentable non-obviousness because no non-obvious structural characteristics are associated with depositing layers of a coating formulation in a pattern on the substrate in the specification. The method of application, spraying, is deemed not to impart patentable non-obviousness because no non-obvious structural characteristics are associated with spraying in the specification.

Peterson does not teach depositing layers of more than one coating formulation. However, O'Siel teaches adding a layer of metal foil to band of self extinguishing material and, "thus isolates or insulates each of the tacky layers from the others for convenience in packaging." (col. 2, 70 -- col. 3, 2). It would have been obvious to one of ordinary skill in the art at the time of invention that the multiple layers disclosed by Peterson could have been made from different materials, such as the metal foil disclosed by O'Siel. Adding such material would assist the handling of paper containing layers of tacky material, preventing the layers from sticking to other pieces of paper

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during manufacture or final cigarettes sticking to one another during packaging and consumption.

As for claim 2, the wrapping is adapted to be useful in a reduced ignition propensity cigarette.

As for claim 3, the cigarette has the transverse bands claimed [figure 2].

As for claim 4, the coatings are applied in predetermined amounts [col. 7 lines 20-45].

As for claim 5, The method of applying coating online is deemed not to impart patentable non-obviousness because no non-obvious structural characteristics are associated with applying coating on line.

As for claim 6, Peterson teaches:

- A wrapping material substrate [col. 1 lines 5-15],
- A plurality of bands [figures 2-4], and
- A pattern [figure 2].

The step, depositing layers of a coating formulation in a pattern on the substrate, is deemed not to impart patentable non-obviousness because no non-obvious structural characteristics are associated with depositing layers of a coating formulation in a pattern on the substrate in the specification. The method of application, applying by ink jet, is deemed not to impart patentable non-obviousness because no non-obvious structural characteristics are associated with applying by ink jet in the specification.

As for claim 7, the wrapping material of Peterson is adapted to be useful in manufacturing reduced ignition proclivity cigarettes.

As for claim 8, the pattern comprises transverse bands of coating with longitudinal widths spaced along the longitudinal length [figures 2-4].

As for claim 9, Peterson teaches applying in predetermined amounts [col. 7 lines 20-45].

As for claim 10, The method of applying coating online is deemed not to impart patentable non-obviousness because no non-obvious structural characteristics are associated with applying coating on line.

As for claim 11, Peterson teaches:

- A wrapping material substrate [col. 1 lines 5-15],
- A plurality of bands [figures 2-4], and
- A pattern [figure 2].
- Multiple layers on top of one another which reduce the porosity of the underlying paper [col. 2 line 55 to col. 3 line 15; col. 7 lines 20-45]

The step, depositing layers of a coating formulation in a pattern on the substrate, is deemed not to impart patentable non-obviousness because no non-obvious structural characteristics are associated with depositing layers of a coating formulation in a pattern on the substrate in the specification. The method of application, spraying, is deemed not to impart patentable non-obviousness because no non-obvious structural characteristics are associated with spraying in the specification.

As for claim 12, see citations in and reasoning from the treatment of claims 6 and 11.

As for claim 19, the bands are on an outside surface of the wrapping paper [figure 2].

As for claim 20, the performance characteristics of the cigarette are altered [col. 2 line 40 to col. 3 line 15].

As for claims 22-25, 29-30, 34-35, and 39-40, several descriptions of the formulation deposited in a pattern are claimed. These further descriptions of the step, depositing a coating formulation, are deemed not to impart patentable non-obviousness because no non-obvious structural characteristics are associated with the steps in the specification.

As for claims 26, 31, 36, and 41, Peterson teaches a solid coating on the substrate [figures 3 and 4]. If any non-obvious structural feature is associated with the depositing as claimed Applicant should point out that feature and why it is necessarily present in the claim.

As for claims 27, 32, 37, and 42, the step, of offline application, is deemed not to impart patentable non-obviousness because no non-obvious structural characteristics are associated with the step in the specification.

Claims **21, 28, 33, and 38** are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson and O'Siel as applied to claims 1, 6, 11, and 12 above.

As for claims 21, 28, 33, and 38, at the time of the invention, it would have been obvious to a person having ordinary skill in the art of cigarette paper manufacture to use

burn control agents in the invention of Peterson because Peterson teaches burn control agents being used in association with reduced porosity bands [col. 2 lines 5-15].

In the event any differences can be shown for the product of the product-by-process claim(s) 1-12 and 19-32, as opposed to the product taught by the reference Peterson, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of showing of unexpected results; see also *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Conclusion

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL J. FELTON whose telephone number is (571)272-4805. The examiner can normally be reached on Monday to Friday, 7:30 AM to 4:30 PM EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJF

/Philip C Tucker/
Supervisory Patent Examiner, Art Unit 1791